

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Mathur, Sanjay et al.

Examiner: Shin, Kyung H.

Application No.: 09/817,917

Group Art Unit: 2143

Filed: March 26, 2001

Docket No.: 33836.00.0028

For: METHOD AND APPARATUS FOR
PROCESSING DATA IN A
CONTENT NETWORK

APPELLANTS' REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Dear Sir:

Appellants submit this reply brief in response to the Examiner's Answer mailed November 12, 2008 ("the Answer") in the above-identified application.

I. Appellants' Reply

A. The Rejection Under 35 U.S.C. § 101 Must Be Reversed Because The Claims Encompass Patentable Subject Matter

1. CLAIM 25

Appellants have noted the response to Appellants' argument (Answer, p. 24), with apparent reference to a portion of M.P.E.P. § 2106.01¹, that “[t]he claim does not contain the computer software and hardware components which permit the data structure's functionality to be realized, thus, it is directed to non-statutory subject matter.” However, this appears to be a misreading of the guidance provided by the M.P.E.P. Indeed, M.P.E.P. §2106.01(I) specifically states that:

[A] claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Thus, a claim reciting a computer-readable medium with a data structure stored thereon **does** define sufficient “structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized.” Stated another way, the recitation of the computer-readable medium necessarily defines the structural and functional interrelationships with the computer software and hardware needed to realize the data structure's functionality. This guidance does **not** require that the

¹ The cite set forth in the Answer is to “MPEP 2106.(I)”, which appears to be an introductory paragraph concerning the so-called “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility”. Given the content of this response (allowing functionality to be “realized”), Appellants believe a citation to either M.P.E.P. § 2106.01 or § 2106.01(I) was intended.

claimed computer-readable medium must recite, in addition to the data structure, some computer software and hardware components that permit the data structure's functionality to be realized.

For these reasons, and those presented in Appellants' Appeal Brief, Appellants respectfully submit that the rejection under Section 101 should be overturned.

B. The Rejection Under 35 U.S.C. 103(a) Based On Slaughter In View Of Sheth Must Be Reversed Because The Cited References Do Not Teach The Claimed Subject Matter As Alleged

1. CLAIMS 7 & 25

Appellants respectfully reassert their arguments presented in their Appeal Brief.

2. CLAIMS 9-12 AND 28

Appellants have noted the response to Appellants' argument (Answer, p. 22) that the cited art does not teach a digital identity acting as a proxy on behalf of an entity, which entity corresponds to the enhanced data being requested by a requestor as recited, for example, in claim 9. Particularly with regard to the citation of col. 73, lines 30-35 of the Slaughter reference, Appellants respectfully reassert their arguments presented in their Appeal Brief.

To the extent that the Answer further states that the "proxy" taught by Slaughter does operate on behalf of the entity (corresponding to the enhanced data), it does so by asserting that Slaughter's proxy serves as a bridge and therefore is operating "on behalf of" both sides of a transaction. However, this line of reasoning would obviate any meaning of the "on behalf of" limitation recited in the claims. It is a common understanding that to act "on behalf of" an entity is to act "as the agent of; on the part of" that thing (definition of "behalf", The American Heritage Dictionary of the English Language, 4th Ed. (2006), p. 162). Thus, the reading of Slaughter's proxy as always operating "on behalf of" any party that it communicates with renders this limitation meaningless because it undermines the agency nature of its definition.

Furthermore, as noted in Appellant's Appeal Brief, this is contrary to the express teachings of Slaughter that state that the proxy taught therein is operating on behalf of the requesting party.

For these reasons, and those presented in Appellants' Appeal Brief, Appellants respectfully submit that the rejection of claims 9-12 and 28 under Section 103 should be overturned.

3. CLAIM 13

Appellants respectfully reassert their arguments presented in their Appeal Brief.

4. CLAIM 14

Appellants respectfully reassert their arguments presented in their Appeal Brief. Furthermore, the Answer does not appear to provide any response to these arguments. Consequently, Appellants presume that the Examiner has acquiesced in Appellant's arguments concerning claim 14.

C. The Rejection Under 35 U.S.C. 103(a) Based On Slaughter In View Of Sheth And In Further View Of Rahman Must Be Reversed Because The Cited References Do Not Teach The Claimed Subject Matter As Alleged

1. CLAIMS 16, 17, 19, 20 AND 29

Appellants respectfully reassert their arguments presented in their Appeal Brief. Furthermore, the additional portions of Slaughter recited in the Answer (col. 8, lines 26-32 and 37-39) concern Slaughter's service discovery capability, which would appear to be more relevant to the first limitation found in, for example, claim 16 of "discovering at least one service offered by at least one entity connected to at least one computer network." To the extent that discovering a service and determining whether that service is acceptable based on its terms are distinct limitations recited in the claims, Appellants respectfully submit that the additional cited portions fail to address the shortcomings of Slaughter previously noted by Appellants, and that the rejection of claim 13 should be overturned.

2. CLAIM 18

Appellants have noted the characterization of their arguments found on page 23 of the Answer, i.e., that Appellant “argues that the referenced prior art does not disclose whether the user’s desired modification to his service can be negotiated between the service and the network.” However, this characterization of Appellants’ arguments is incorrect. A careful reading of Appellants’ arguments reveals that Appellants argue that Rahman fails to teach the claimed limitation of negotiating terms of a discovered service, but instead teaches a modification of an existing service.

The Answer, on page 24, further states that “Applicant has indicated negotiation with a network.” Appellants are uncertain as to the meaning of this statement. Appellants have argued that the teaching of Rahman (as opposed to the instant claims) concern a determination “whether the user’s desired modification to his service can be negotiated between the service and the network.” To the extent that the response to Appellants’ arguments appears to be premised on a faulty understanding of Appellants’ arguments, Appellants respectfully reassert their arguments presented in their Appeal Brief.

II. Conclusion

For the reasons advanced above, Appellants submit that the Examiner erred in rejecting pending claims 7, 9-14, 16-20, 25, 28 and 29 and respectfully request reversal of the decision of the Examiner.

Respectfully submitted,



Date: 12/16/2008

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